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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,675	07/23/2003	Rod Berube	00167-362002	6691
26166 7590 02/28/2007 FISH & RICHARDSON P.C. SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			EXAMINER WOO, JULIAN W	
			ART UNIT	PAPER NUMBER
			3731	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/28/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/624,675

Applicant(s)

BERUBE ET AL. ✓

Examiner

Julian W. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 55-88 is/are pending in the application.
- 4a) Of the above claim(s) 69-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-68 and 81-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 55 is objected to because of an informality, which can be corrected as follows: In line 9, after "length," insert --of the head--, in order to specify what "maximum transverse cross-sectional length" is being used as dimensional reference. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 66, 68, 81, 86, and 87 are rejected under 35 U.S.C. 102(b) as being anticipated by Gourd (5,061,137). Gourd discloses, at least in figures 1-4 and col. 4, lines 20-68; a tissue fastener including a hollow shaft (4, 6, 10) defining a substantially void interior passage and having an outer wall at least partially defining an exterior surface, a generally rigid member (6) disposed one the shaft, and a generally rigid, solid tissue engaging head (8) disposed at an end of the shaft and having a maximum transverse cross-sectional length longer than the maximum transverse cross-sectional length of the hollow shaft, where the shaft (at 10) is relatively flexible between the member and the head, where the head includes an opening (12) in communication with the passage, where the member (6) includes at least one barb (13), and where the head is disposed at the relatively flexible region of the shaft.

4. Claims 55-57, 59-62, 64, 65, 67, 81-85, and 88-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowald (5,425,766). Bowald discloses, in figure 1 and in col. 3, lines 34-49 and col. 5 line 47 to col. 6, line 12; a bioabsorbable, polymeric tissue fastener including a shaft (2) having a generally rigid member (4) disposed thereon; a generally rigid tissue engaging head (8) having a maximum transverse cross-sectional length longer than the maximum cross-sectional length of the shaft, the head including a maximum longitudinal cross-sectional length shorter than the maximum transverse cross-sectional length of the head; and a region of the shaft (2) being formed of a woven mesh between the head and the member, where the region comprises substantially an entire length of the shaft, where the shaft is hollow and defines an interior passage (which accommodates at least a guidewire (10)), where the passage is open at a distal end of the shaft, where the head has a flat and toothed distal surface (at 9), where the head and member are molded onto the mesh.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 55, 58, 61, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gourd (5,061,137) in view of Lewis et al. (5,382,257). Gourd discloses the invention substantially as claimed. Gourd discloses a tissue fastener including a region of the shaft (10) that provides transverse flexibility and longitudinal extensibility, a member (6) having a barb (13), and a passage closed at the distal end of the shaft (at 6). However, Gourd does not disclose that the region of the shaft is formed of a woven mesh. Lewis teaches, in fig. 1A and in col. 2, lines 32-39 and col. 4, lines 45-47; a hollow tissue fastener (21) comprising a woven mesh. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Lewis, to form the region of Gourd's shaft from a woven mesh. Such a configuration would strengthen the region and allow the region to withstand the stresses and strains of movement of the head with respect to the shaft with less risk of catastrophic failure.

#### ***Response to Amendment***

7. Applicant's arguments with respect to claims 55-68 and 81-91 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-

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4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julian W. Woo  
Primary Examiner

February 27, 2007